



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,574	07/16/2001	Takehiko Shioda	FUJI.007	2363

21254 7590 08/03/2005

MCGINN & GIBB, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

EXAMINER

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
----------	--------------

3627

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,574

Applicant(s)

SHIODA ET AL.

Examiner

Marissa Thein

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 31, 32 and 34-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 31, 32 and 34-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's "Amendment under 37 CFR 1.111" has been considered.

Applicant's response by virtue of amendment to claims 1-14, and 31-32 has overcome the Examiner's rejection of such claims under 35 USC 112, second paragraph.

Claims 1-4, 6-8, 11-14, and 31-32 have been amended. Claims 15-30 and 33 are canceled. New claims 34-41 have been added. Claims 1-14-31-32, and 34-41 remain pending in this application.

Claim Objections

Claim 41 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It appears claim 41 repeats part of the recitation in claim 40.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 5-6, 9, 11, 14, and 31-32 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,101,483 to Petrovich et al.

Regarding claims 1-2, 5-6, 9, 11, and 31-32, Petrovich discloses an information service providing method for providing an information service to a plurality of information terminals through communication line comprising: receiving a request from the information terminal through a first communication line (home personal computer 68, col. 6, lines 9-11; col. 9, lines 40-50); sending a reply to the request to the information terminal through at least one of said first communication (home personal computer) and a second communication line (portable terminal 40) which is different from the first communication line, depending on a content of the said request (col. 11, lines 18-25, Figure 1). Furthermore, Petrovich disclose a first information terminal (home computer); and a second information terminal (portable terminal); and an information providing apparatus (host computer 16) for sending the desired information to the information terminal through a second communication line, col. 9, lines 12-25). Moreover, Petrovich discloses the first communication line includes an Internet line (Internet, col. 4, lines 4-5).

Regarding claim 14, Petrovich discloses a mobile communication terminal (portable terminal 40).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3627

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,101,483 to Petrovich et al. Although the reference is silent to the particular communication line, it would have been obvious to one of ordinary skill in the art to have provided the communication line already disclosed by Petrovich to have been a communication line capable of performing temporary communication, such communication line would have been recognized by the skilled artisan as being one of numerous communication line suitable for communicating. Moreover, applicant has not persuasively demonstrated that the particular communication line is critical or is anything more than one of the numerous communication lines that the skilled artisan would have found suitable for the purpose taught by Petrovich. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a communication line capable of performing temporary communication, such as the communication line taught in Petrovich, for the purpose of having a two-way communication.

Claims 4, 8, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,101,483 to Petrovich et al. in view of U.S. Patent No. 5,983,100 to Johansson et al.

Regarding claims 4, 8, and 13, Petrovich substantially discloses the claimed invention, however, it does not explicitly disclose the switched subscriber line for governing telephone communication. Petrovich discloses a portable terminal which includes a wireless transceiver which is coupled to the memory and which is configured

for wireless communication with the optional at least one wireless multi-access point when a user of the system takes the portable terminal into a shopping establishment (col. 5, lines 9-14).

Johansson, on the other hand, discloses the switched subscriber line for governing telephone communication (col. 6, lines 31-41; col. 8, lines -13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method, system, terminal, and apparatus of Petrovich, to include the switched subscriber line for governing telephone communication, as taught by Johansson, in order to provide a two-way communication device which are selectable operable to communicate with each other (Johansson, col. 3, lines 27-29).

Regarding claim 10, Petrovich substantially discloses the claimed invention, however, it does not disclose short-range radio interface. Petrovich discloses a portable terminal which includes a wireless transceiver which is coupled to the memory and which is configured for wireless communication with the optional at least one wireless multi-access point when a user of the system takes the portable terminal into a shopping establishment (col. 5, lines 9-14).

Johansson, on the other hand, discloses the short-range interface (col. 6, lines 31-41).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method, system, terminal, and apparatus of Petrovich, to include the short-range interface, as taught by Johansson, in order to

provide a two-way communication device which are selectable operable to communicate with each other (Johansson, col. 3, lines 27-29).

Claims 34-41 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,101,483 to Petrovich et al. in view of U.S. Patent No. 5,602,916 to Grube et al. Petrovich substantially discloses the claimed invention, however, it does not explicitly disclose the request is directed to information, which is to be at least one of served from and prevented from being monitored by others. Petrovich discloses a system and method comprising a host computer; a shopping establishment kiosk cradle; a portable terminal; and a home cradle which includes a home portable terminal-receiving station and a home data interface which is associated with the home portable terminal-receiving station (col. 2, lines 15-20; col. 2, lines 37-40). The portable terminal contains intrinsic identifying indicia to identify the user (col. 2, lines 54-55). The portable terminal is used in the home and the data associated with the barcodes is transferred to the data interface of the home portable terminal receiving station, host computer can send at least one verification query to home cradle in order to verify at least one of correctness and validity of an order which is based on the shopping list data (col. 9, lines 12-18). The step of sending the verification query can include sending the verification query as a human language audible query to the telephone which is coupled to the home cradle and can include sending the verification query as a signal which triggers visual display of the verification information on display of portable terminal. The verification query process can also include caller identification to prevent theft of goods and/or services. (Col. 9, lines 18-26) The verification queries can include final price and

confirmation of the user's order (col. 11, lines 19-20). The verification queries can be sent in written form to display of portable terminal or to separate home computer in order to save time for the user (col. 11, lines 21-24).

Grube, on the other hand, teaches the request is directed to information, which is to be at least one of secured from and prevented from being monitored by others (abstract; col. 2, lines 39-57; col. 3, lines 31-58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method, system and apparatus of Petrovich, to include the request is directed to information, which is to be at least one of secured from and prevented from being monitored by others, as taught by Grube, in order to prevent unauthorized reception or monitoring of wireless data transmission (Grube, col. 2, lines 18-19; col. 2, lines 40-41).

Response to Arguments

Applicant's arguments filed May 23, 2005 have been fully considered but they are not persuasive.

Applicant remarks that "Petrovich does not disclose or suggest "receiving a request from said information terminals through a first communication line; and sending a reply to the request to the information terminal through at least one of said first communication line and a second communication line, which is different from said first communication line, depending on a content of said request".

The Examiner notes that Petrovich does disclose or suggest "receiving a request from said information terminals through a first communication line; and sending a reply

Art Unit: 3627

to the request to the information terminal through at least one of said first communication line and a second communication line, which is different from said first communication line, depending on a content of said request". Petrovich discloses a personal shopping system for combined use in both the home of the user and at least one shopping establishment (col. 2, lines 13-15). The system includes a host computer coupled to a host modem; and a shopping establishment kiosk cradle; a portable terminal which comprises a two-way data interface configured to read bar codes associated with items related to shopping; and a home cradle which includes a home portable terminal-receiving station and a home data interface which is associated with the home portable terminal-receiving station (col. 2, lines 15-20; col. 2, lines 37-40). The portable terminal contains intrinsic identifying indicia to identify the user (col. 2, lines 54-55). The portable terminal is used in the home and the data associated with the barcodes is transferred to the data interface of the home portable terminal receiving station, host computer can send at least one verification query to home cradle in order to verify at least one of correctness and validity of an order which is based on the shopping list data (col. 9, lines 12-18). The step of sending the verification query can include sending the verification query as a human language audible query to the telephone which is coupled to the home cradle and can include sending the verification query as a signal which triggers visual display of the verification information on display of portable terminal. The verification query process can also include caller identification to prevent theft of goods and/or services. (Col. 9, lines 18-26) The verification queries can include final price and confirmation of the user's order (col. 11, lines 19-20). The

verification queries can be sent in written form to display of portable terminal or to separate home computer in order to save time for the user (col. 11, lines 21-24).

Such system comprising host computer, kiosk cradle, portable terminal, and home cradle, wherein the portable terminal is used in the home and the data associated with the barcodes is transferred to the data interface of the home portable terminal receiving station, host computer can send at least one verification query to home cradle in order to verify at least one of correctness and validity of an order which is based on the shopping list data; sending the verification query can include sending the verification query as a human language audible query to the telephone which is coupled to the home cradle and can include sending the verification query as a signal which triggers visual display of the verification information on display of portable terminal; and sending the verification queries in written form to display of portable terminal or to separate home computer in order to save time for the user are considered "receiving a request from said information terminals through a first communication line; and sending a reply to the request to the information terminal through at least one of said first communication line and a second communication line, which is different from said first communication line, depending on a content of said request".

The Examiner notes that the claim was given the broadest reasonable interpretation in an effort to reduce the possibility that these claims, once issued, will be interpreted more broadly than is justified. *See In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969).

Applicant remark "that whether the information can be sent by voice or in written form to be displayed in order to save the user time is not the same or comparable to the claimed content of the 'request' itself (e.g. a request for a password or other information to be prevented from being monitored by others)".

The Examiner notes that Petrovich discloses the request itself, as discussed above. In response to applicant's remark that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a request for a password or other information to be prevented from being monitored by others) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant remarks that "Petrovich does not disclose or suggest sending a request signal for requesting desired information through from an information terminal through a first communication line, and on the other hand, sending the desired information back to the information terminal through a second communication line in response to the request signal received through the first communication line".

The Examiner notes that Petrovich "discloses or suggests sending a request signal for requesting desired information through from an information terminal through a first communication line, and on the other hand, sending the desired information back to the information terminal through a second communication line in response to the request signal received through the first communication line". The system includes a host computer coupled to a host modem; and a shopping establishment kiosk cradle; a

portable terminal which comprises a two-way data interface configured to read bar codes associated with items related to shopping; and a home cradle which includes a home portable terminal-receiving station and a home data interface which is associated with the home portable terminal-receiving station (col. 2, lines 15-20; col. 2, lines 37-40). The portable terminal is used in the home and the data associated with the barcodes is transferred to the data interface of the home portable terminal receiving station, host computer can send at least one verification query to home cradle in order to verify at least one of correctness and validity of an order which is based on the shopping list data (col. 9, lines 12-18). The step of sending the verification query can include sending the verification query as a human language audible query to the telephone which is coupled to the home cradle and can include sending the verification query as a signal which triggers visual display of the verification information on display of portable terminal. The verification query process can also include caller identification to prevent theft of goods and/or services. (Col. 9, lines 18-26) The verification queries can be sent in written form to display of portable terminal or to separate home computer in order to save time for the user (col. 11, lines 21-24).

Such portable terminal which is used in the home and the data associated with the barcodes is transferred to the data interface of the home portable terminal receiving station, host computer can send at least one verification query to home cradle in order to verify at least one of correctness and validity of an order which is based on the shopping list data; sending the verification query can include sending the verification query as a human language audible query to the telephone which is coupled to the

home cradle and can include sending the verification query as a signal which triggers visual display of the verification information on display of portable terminal; and sending the verification queries in written form to display of portable terminal or to separate home computer in order to save time for the user are considered "sending a request signal for requesting desired information through from an information terminal through a first communication line, and on the other hand, sending the desired information back to the information terminal through a second communication line in response to the request signal received through the first communication line".

The Examiner notes that the claim was given the broadest reasonable interpretation in an effort to reduce the possibility that these claims, once issued, will be interpreted more broadly than is justified. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969).

Applicant remarks that "Petrovich clearly does not, however, disclose or suggest or even contemplate sending a request through a first communication line and then sending a response through a second (different) communication line, in order to provide secure information service".

The Examiner notes that Petrovich discloses the "sending a request through a first communication line and then sending a response through a second communication line", as discussed above. In response to applicant's remark that the reference does not disclose or suggest to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., secure information) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further remarks that “Petrovich also does not disclose, suggest or even contemplate the novel and unobvious features of the claimed invention, which are capable of providing high security information services”.

In response to applicant's remark that the reference does not disclose or suggest to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., high security information services) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant remarks that “ Johnson does not make up for the deficiencies of Petrovich. For example Johansson also does not disclose or suggest at least “receiving a request from said information terminals through a first communication line; and sending a reply to the request to the information terminal through at least one of said first communication line and a second communication line, which is different from said first communication line, depending on a content of said request”.

The Examiner notes that Petrovich was cited for disclosing the “receiving a request from said information terminals through a first communication line; and sending a reply to the request to the information terminal through at least one of said first communication line and a second communication line, which is different from said first communication line, depending on a content of said request”, as discussed above. The

Examiner then turns to Johansson, which was cited for teaching the switched subscriber line for governing telephone communication.

Applicant remarks that Examiner has not reached the issues of motivation to combine these references or the combinability of these references".

In response to applicant's remark that the Examiner has not reaches issues of motivation to combine these references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation was found in Johansson, col. 3, lines 27-29.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3627

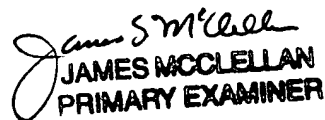
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mtot
August 1, 2005


JAMES MCCLELLAN
PRIMARY EXAMINER